

ESTTA Tracking number: **ESTTA198927**

Filing date: **03/18/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91181975
Party	Plaintiff Joanna Villeneuve and Melanie Villeneuve
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Attachments	VilleneuveMTDOpp.PDF (10 pages)(864036 bytes)

JOANNA VILLENEUVE and)	
MÉLANIE VILLENEUVE,)	
)	
Opposers,)	Mark: GILLES VILLENEUVE
)	Serial No.: 79/030,057
v.)	Published: 18 September 2007
)	
GOLDSTAR HOLDINGS CORP.)	Opposition No. 91181975
)	
Applicant.)	
)	

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STATEMENT OF RELEVANT FACTS

The Opposition alleges that the Opposers are heirs and beneficiaries of the estate of Gilles Villeneuve, a Formula One race car driver famous in the United States, as well as internationally, for his successful racing career. (Opposition ¶¶ 3-5). As such, upon his death Opposers succeeded to Mr. Villeneuve's interests in all his assets, including the trademark rights in the name GILLES VILLENEUVE. (*Id.* ¶ 3). Opposers further alleged that significant fame and goodwill are associated with his name in the United States and abroad, and Applicant Goldstar's attempt to trademark his name, if successful, would allow Goldstar to inappropriately trade on the goodwill which the Opposers hold in the GILLES VILLENEUVE name. (*Id.* ¶¶ 5-6). They assert that Goldstar has no right or connection to that name and its use of it would suggest a false connection to Mr. Villeneuve and the Villeneuve family, causing damage to the Opposers. (*Id.* ¶¶ 6-9).

STANDARD FOR A MOTION TO DISMISS

A party opposing a registration pursuant to Section 13 of the Lanham Act must show, by alleging sufficient facts in support, that (1) he has standing, and (2) there is a statutory ground which negates the applicant's entitlement to registration, *i.e.*, a valid ground exists for opposing the mark. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1214 (TTAB 2006). However, alleging sufficient facts in the pleading context consists of asserting only a "short and plain statement." *Young v. AGB Corp.*, 47 USPQ2d 1752, 1754 (TTAB 1998) (quoting 37 C.F.R. Section 2.104(a)). A motion to dismiss relies solely on the factual allegations of the pleadings, and "all well pleaded factual allegations of the 'complaint'

are accepted as true and the ‘complaint’ is viewed in the light most favorable to the non-moving party.” *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 , 1218 (TTAB 1990).

Further, “a motion to dismiss for failure to state a claim upon which relief can be granted must be construed by a tribunal, such as the Trademark Trial and Appeal Board, so as to do substantial justice. A party should not be denied his right to be heard on a notice of opposition unless it is certain beyond any doubt that he cannot prevail under any circumstances.” *See Stabilisierungsfonds für Wein v. Zimmermann-Graeff KG*, 199 USPQ 488, 489 (1978) (internal citations omitted). This means that the tribunal must examine the entire pleading and, as required by Fed.R.Civ.P. 8(f), construe the allegations therein liberally, “to determine whether it contains any allegations, which, if proved, would entitle plaintiff to the relief sought.” *McDermott*, 81 USPQ2d at 1214, *citing Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

ARGUMENT

1. The Opposers Have Properly Alleged Facts Sufficient To Establish Standing

Goldstar asserts in its Motion to Dismiss that the Opposers have failed to show standing because they have not: (1) shown a valid ground for refusing registration, and therefore a nexus to the harm; and (2) sufficiently shown damages. These contentions are false, as Opposers have alleged both that they have a personal interest, over and above that of the general public, in opposing the registration of Gilles Villeneuve’s name, and that their right to protect Mr. Villeneuve’s identity would be harmed.

An Opposer’s standing to bring an opposition arises out of Section 13 of the Lanham Act, which states, “[a]ny person who believes that he would be damaged by the registration of a mark

upon the principal register may . . . file an opposition . . . stating the grounds therefor.” *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987), quoting 15 U.S.C. § 1063 (1982). The *Jewelers Vigilance Committee* Court noted that there is no definition of damages in the above referenced portion of Section 13 of the Act, but that “[t]he purpose in requiring standing is to prevent litigation where there is no real controversy between the parties, where a plaintiff, petitioner or opposer, is no more than an intermeddler. . . the gist of the question of standing is whether plaintiff alleged such a personal stake in the outcome of the controversy as to assure that concrete adverseness which sharpens the presentation of issues.” *Id.* at 2023; *see also Young*, 47 USPQ2d at 1753. Here, the Opposers are not unrelated third parties; they are the widow and daughter of Mr. Villeneuve and beneficiaries of his estate, and have the right, as beneficiaries, to his trademark and other rights in the name GILLES VILLENEUVE.

The portion of Section 2(a) which bars the registration of a mark that would falsely suggest a connection with a living or dead person exists to protect and control the use of one’s identity. *Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512, 514 (TTAB 1984). That is what the Opposers are trying to protect — Mr. Villeneuve’s identity and reputation — and their damage would arise from their inability to protect and control the manner and circumstance in which he is portrayed to the world. The Board has upheld similar claims in the past. For example, in *Isabelle Canovas v. Venezia*, 220 USPQ 660 (TTAB 1983), the Board found that an opposer had standing because she pled facts that stated her belief that the mark applicant sought to register was her name. *See also Springs Industries, Inc.*, 222 USPQ at

514 (citing the *Canovas* decision finding standing when opposer sought to block use of her name).

Moreover, it is well-established that standing can be alleged, not only by the individual, but by the heirs of the person whose name is being used. *Association Pour La Defense et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838, 1842 (TTAB 2007). In the recent *Chagall* opposition, the Opposer derived its standing from one of its members, the granddaughter of the painter Marc Chagall, who alleged that her rights were derived by inheritance from Marc Chagall. *Id.* at 1839. Similarly here, the Opposers have alleged that they are the heirs to the estate of Gilles Villeneuve, including the rights to his name. (See Opposition ¶3). Accordingly, the Villeneuves, like Chagall's granddaughter, derive their interest in the opposition to the registration in order to protect Mr. Villeneuve's identity, through those rights of inheritance.

Additionally, a key basis for this opposition is the same as that of the opposers in *Canovas* and *Chagall*. All alleged that allowing this unrelated person or entity to register the person's name suggested a false connection to that person under Section 2(a) of the Lanham Act, and that false connection is a basis for opposition under Section 13.

Accordingly, having properly alleged both a particular interest in the matter and a basis for Opposition under Section 2, any motion to dismiss based on lack of standing is without merit and should be denied.

**2. The Opposition Should Not Be Dismissed
For Failure To State A Claim**

a. The Opposition States a Claim Under Section 2(a)

Tellingly, for all its vituperation, the Applicant makes little mention of Section 2(a) and its obvious relevance here. Under that portion of Section 2(a) dealing with a false suggestion of a connection, the opposer must allege facts which could establish that:

(1) [t]he mark must be shown to be the same as or a close approximation of the person's previously used name or identity; (2) it (or part of it) would be recognized as such; (3) that the person in question is not connected with the goods or services of the applicant; and (4) the person's name or identity must be of sufficient fame that when it is used as part or all of the mark on applicant's goods, a connection with that person is likely to be made by someone considering purchasing the goods.

In re Debbie Sauer, 27 U.S.P.Q.2d 1073, 1074, 1993 WL 236534 (TTAB 1993), citing *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985). Additionally, “an opposer must plead not only the likelihood of confusion as to source but also an intent by defendant to trade upon plaintiff’s goodwill as the prior user.” *See Springs Industries, Inc.*, 222 USPQ at 514. “The initial and critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or ‘persona.’” *Id.*

Opposers have satisfied all four requirements to plead an opposition under Section 2(a). With respect to the first two requirements, Opposers have alleged the mark at issue, GILLES VILLENEUVE is the same as the name of their decedent; Opposers have further alleged that this name is well known in the United States and abroad, and so would be recognized as such. (*See* Opposition ¶¶ 4-5); *Sauer*, 27 U.S.P.Q.2d at 1074. The Opposers satisfied the third requirement because they alleged that Goldstar does not have their permission to register the name of Gilles Villeneuve as a trademark for Goldstar’s benefit. (*See* Opposition ¶ 7); *Sauer*, 27 U.S.P.Q.2d at

1074. Meeting the fourth requirement of fame, Opposers have alleged that Villeneuve is an iconic figure in the sport of Formula One Racing in the United States and abroad, (Opposition ¶ 5), and have expressly alleged that Applicant would be trading, unfairly, on the goodwill associated with the iconic figure's name. (See Opposition ¶¶ 4-5, 8). Accordingly, all the elements required by the Board to allege a 2(a) case are satisfied. See *id.*; *Sauer*, 27 U.S.P.Q.2d at 1074.

Applicant cites two cases, *In re Mohawk Air Services, Inc.*, 196 USPQ 851, 854-855 (TTAB 1977), and *In re Nuclear Research Corp.*, 16 USPQ2d 1316, 1317 (TTAB 1990), for the proposition that under Section 2(a) an opponent must show that they are a prior user. Those cases are inapposite here. Both *Mohawk* and *Nuclear Research* dealt with organizations or entities that wanted to claim the use of a name or acronym as a mark associated with their organization or entity. Those cases did not involve a person or personal identity. Here, there is no question that the mark at issue is the name of the late race car driver Gilles Villeneuve, and the Opposers alleged that there would be a connection to him in the mind of the purchasing public. (Opposition ¶ 8) (“...there is a very high likelihood that purchaser and potential purchasers of Applicant’s goods will be confused or deceived into believing that the goods have been authorized or endorsed by the Villeneuve family.”). Moreover, the Board has specifically found that “an opposer may prevail even if the name claimed to be appropriated has never been commercially exploited by the opposer in a trademark or trademark analogous manner.” See *Buffett*, 226 USPQ at 429.

b. The Opposition states a claim under Section 2(d).

In addition to Section 2(a), Opposers have also adequately set forth a claim under Section 2(d). Under Section 2(d), Opposers must “prove ownership of a registration and/or priority of use, and likelihood of confusion.” *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007); *see also Continental Specialties Corp. v. Continental Connector Corp.*, 192 USPQ 449, 451 (TTAB 1976) (holding that, under §2(d), opposer must show that “opposer’s use at least antedates the filing date of the application sought to be opposed.”). All of the Opposers allegations are taken as true and viewed in their favor. *Space Base Inc.*, 17 USPQ2d at 1218.

Here, Opposers alleged the preexisting interest they have in the GILLES VILLENEUVE name and that they have the right to use the name in commerce. (*See* Opposition ¶¶ 3, 7). Additionally, the Opposers alleged that the mark proposed by Goldstar is identical to the GILLES VILLENEUVE name, in which they have an interest, (*see* Opposition ¶ 3), which satisfies the requirements of a §2(d) claim, *Barbara’s Bakery Inc.*, 82 USPQ2d at 1285.

In *Springs Industries, Inc.*, 222 USPQ at 514, the petitioner alleged that the applicant’s mark so resembled its mark, that applicant’s use of its mark on its goods would falsely suggest a connection with petitioner. The Board found that “[t]he essence of this allegation. . . is that confusion as to source would be likely to result from the contemporaneous use of the parties’ marks on their respective goods. An allegation such as petitioner’s is sufficient to state a claim under Section 2(d).” *Id.* (where petitioner alleged that it had been continuously using its mark since the 1950s). Similarly, Opposers here have alleged that purchasers would be confused or deceived by Applicant’s mark on Applicant’s goods into thinking that there was a connection to

or endorsement by the Villeneuve family. (See Opposition ¶ 8). The Opposers, like the *Spring Industries, Inc.* petitioners, have alleged sufficient facts to survive a motion to dismiss.

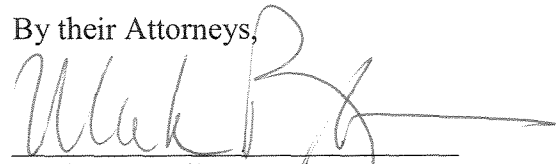
CONCLUSION

For the foregoing reasons, Opposers Joanna Villeneuve and Mélanie Villeneuve respectfully request that the Board deny Applicant's Motion to Dismiss, issue a new scheduling order, and grant such other and further relief as the Board deems just and proper.

Respectfully submitted,

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By their Attorneys,



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Dated: March 17, 2008

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and accurate copy of the foregoing document was served on March 18, 2008, upon counsel for Applicant by e-mail and by first class mail, postage prepaid, addressed to:

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